

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor: NODA, KAZUKI
Application No.: 10/595678 Confirmation No.: 4637
Filed: October 15, 2004 Group Art Unit: 2894
Title: SEMICONDUCTOR SURFACE PROTECTING SHEET AND METHOD

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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July 14, 2009	/Kathleen M. Sandvig/
Date	Signed by: Kathleen M. Sandvig

Dear Sir:

In response to the final action dated March 26, 2009, and prior to filing an appeal brief, a Panel Review of the legal and factual basis of the rejections in the above-identified application is hereby requested. No amendments are being filed with this request. This Pre-Appeal Brief and Request for Review is being filed with a Notice of Appeal.

Fees

- ☐ Any required fee will be made at the time of submission via EFS-Web. In the event fees are not or cannot be paid at the time of EFS-Web submission, please charge any fees under 37 CFR § 1.17 which may be required to Deposit Account No. 13-3723.
- ☐ Please charge any fees under 37 CFR §§ 1.16 and 1.17 which may be required to Deposit Account No. 13-3723.
- ☒ Please charge any additional fees associated with the prosecution of this application to Deposit Account No. 13-3723. This authorization includes the fee for any necessary extension of time under 37 CFR § 1.136(a). To the extent any such extension should become necessary, it is hereby requested.
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REMARKS

Status of the Claims:

The pending claims are claims 1-12. Claims 1-12 stand rejected.

Review is requested for the following reasons:

This review is being requested for two reasons. First, the Appellants' position is that the Examiner has erred by relying on "common knowledge" for the first time in the Advisory Action which does not allow Appellants opportunity to traverse this "common knowledge" and to demand for the Examiner to produce authority for his statement as allowed under MPEP § 2144.03(C). Second, the Appellants assert that the Examiner has not made a *prima facie* case of anticipation by Oka (US 6551906) under 35 U.S.C. 102(e) of claim 1 or *prima facie* cases of obviousness (Oka is the primary reference) under 35 U.S.C. 103(a) of claims 2-12. These issues are now addressed.

With regards to the first issue, in the Advisory Action dated June 24, 2009, the Examiner stated on page 2 that

One with common knowledge in the art would know that when the UV curing resin is layered onto the IC it is "hardened" in order to protect the IC. When the resin is to be removed, it is "hardened" even further, causing it to become brittle and removable. Thus, there are two hardening stages, the latter being the extreme. Since Oka uses UV curing resin, it would have been obvious for him to utilize this method. Thus, Oka's teachings do read on the limitations of claim 1 which states that the resin must be hardened before grinding takes place.

The Appellants' are unaware that it is common knowledge in the art that when the UV curing resin is layered onto the IC it is hardened in order to protect the IC and that when it is to be removed it is hardened even further—that there are two hardening stages. An IC can be adhered to a pressure-sensitive adhesive (PSA) tape that has a UV curing resin without hardening the tape. There is no requirement that a pressure-sensitive adhesive (even if it contains a UV curing resin for later processing) needs to be hardened when adhering it to an IC. Furthermore, the Appellants' position is that the Examiner has erred by presenting this "common knowledge" argument for the first time in the Advisory Action which does not allow the Appellant the opportunity to traverse and require the Examiner to provide evidentiary support (see MPEP § 2144.03(C)). The Appellants respectfully request that the finality of the

rejections be removed and that the Examiner provide evidentiary support for this “common knowledge” statement.

With regards to the second issue, claim 1 stands rejected under 35 U.S.C. 102(e) as purportedly being anticipated by Oka (US 6551906). The Appellants contend that the Examiner has erred by failing to make a *prima facie* case of anticipation under 35 U.S.C. 102(e). It is the Appellants’ position that Oka does not teach each and every element of Appellants’ claim 1 as pointed out in Amendment and Response Under 37 CRF § 1.116, filed May 26, 2009. Specifically, in the final Office Action, the Examiner states that Oka teaches joining the circuit side of said semiconductor wafer to a polymeric film material via a fluid surface protecting layer which hardens upon radiation exposure and hardening said surface protecting layer and then grinding said wafer (see page 2 of final Office Action). However, as pointed out in Appellants’ response of May 26, 2009, Oka does not teach or suggest that grinding the wafer is done after hardening the surface protecting layer as required by Appellants’ claim 1 (emphasis added). It is the Appellants’ position that the Examiner is “reading into” Oka the “two hardening stages” that the Examiner (only in the Advisory Action) states is common knowledge. Oka only teaches that the hardening (or irradiation) of the UV curing resin (col. 3, line 62 of Oka) is done after the grinding (col. 3, line 47 of Oka). Since Oka does not teach each and every element of Appellants’ claim 1 as required by MPEP § 2131, the Examiner has failed to establish a *prima facie* case of anticipation and the Appellants respectfully request that the rejection be withdrawn.

Review and withdrawal of this rejection are respectfully requested.

Claims 2 and 3 stand rejected under 35 U.S.C. §103(a) as purportedly being unpatentable over Oka as applied to claim 1 and further in view of Morita et al. (5516858). Claims 4, 5, 6, 9, and 10 stand rejected 35 U.S.C. §103(a) as purportedly being unpatentable over Oka, in view of Morita, in further view of Hosomi et al (5726219). Claims 7 and 8 stand rejected 35 U.S.C. §103(a) as purportedly being unpatentable over Oka, in view of Morita, in further view of Hosomi, in further view of Komiyama et al. (5,118,567). Claims 11 and 12 stand rejected 35 U.S.C. §103(a) as purportedly being unpatentable over Oka, in view of Morita, in further view of Hosomi, in further view of Komiyama, in further view of Hosomi (5726219).

The Appellants traverse all of these rejections on that basis that Oka does not teach or suggest each and every element of Appellants' claim 2-12 and the secondary references do not add to this teaching. Accordingly the Examiner has not made proper *prima facie* cases of obviousness over claims 2-12 as required by MPEP § 2144 and the Appellants respectfully request that these rejections be withdrawn.

Review and withdrawal of this rejection are respectfully requested.

Conclusion

By setting forth the clear grounds of error, Appellants do not assert that these are the only errors that the Examiner has made, nor do Appellants waive any arguments that may be asserted in an Appeal Brief. Accordingly, Appellants reserve the right to present additional arguments in the Appeal Brief in relation to the independent and also the dependent claims.

Appellants respectfully request that the Panel review and reverse the final rejections of claims 1-12 in the above-identified application, and that a Panel Decision allowing the application on the existing claims be issued.

Respectfully submitted,

Date 14-July-2009

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